

REMARKS

Applicants request that claims 8 and 23 be cancelled without comment, prejudice or disclaimer.

Applicants direct the Examiner's attention to new dependent claim 35 and new independent claim 36. Each of claims 35 and 36 are supported by the application as filed. No new matter has been added.

Applicants respectfully traverse the rejection of claims 1-7, 9-22 and 24-34 under 35 U.S.C. §103(a) over European Patent No. EP 1160708 A1 ("Utsumi") in view of BountyQuest website ("BountyQuest") <www.bountyquest.com>, 5/15/2001, as downloaded via archive.org, at page 2, paragraph 4 of the Office Action. Because no motivation for the asserted combination of Utsumi with BountyQuest exists, the asserted combination is improper and should be withdrawn. Even if made, the asserted combination fails to disclose at least one element of claims 1-7, 9-22 and 24-34. Thus, the rejection of claims 1-7, 9-22 and 24-34 should be withdrawn.

1. No Motivation Exists to Combine Utsumi with BountyQuest

Utsumi discloses a system which solicits from third parties information about products supposedly infringing on a right holder's lawful right. *See Utsumi*, Abstract. The system of Utsumi allows patent holders to disclose their rights in order to solicit information about possible infringement, so that such rights are "easily exercised and protected, effectively utilized, and more extensively circulated than before." *See Utsumi*, p. 2, paragraph 0006.

BountyQuest discloses a website allowing a user to provide prior art information regarding a patent. *See BountyQuest*, p. 10, first paragraph. BountyQuest discloses an example of "Winning Prior Art" showing user-provided references published before a specified date, where the user details how each patent claim element is anticipated by the Prior Art references. *See BountyQuest*, pp. 18-22.

The Office Action states:

Both references are in the same general field of endeavor, since both references deal with the solicitation of prior art, and both deal in the realm of IP infringement.

See Office Action, passim.

Applicants disagree. Utsumi discloses a system for efficiently soliciting information about products infringing on a valid patent. *See Utsumi, Abstract.* In contrast, BountyQuest provides awards to locators of prior art specifically tailored to invalidate a patent. *See BountyQuest, pp. 18-22.*

Applicants note that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Utsumi provides a system for efficient enforcement of patents, allowing users to input information relating to infringement of a given patent. It would be undesirable to modify Utsumi by adding input fields for specifying prior art to invalidate the given patent as BountyQuest teaches.

Applicants further note that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Adding to the system of Utsumi input fields for specifying prior art to invalidate a particular patent would render the system unsatisfactory for its purpose of enabling efficient enforcement of patents. Generally, patent holders seeking to enforce their patents prefer not to entice the public to search for prior art that would invalidate their patents. Adding a mechanism to invalidate a patent in Utsumi's system designed to enforce patents, as the Examiner proposes in the asserted combination, would render Utsumi's system unsatisfactory for its intended purpose.

The Examiner has failed to produce any teaching or suggestion within the cited references for the asserted combination. The conflicting purposes of Utsumi and BountyQuest underscore the undesirability, rather than the desirability, of the asserted combination. Furthermore, the modification to Utsumi proposed by the Examiner would render the system of Utsumi unsatisfactory for its intended purpose. Therefore, the asserted combination is improper and should be withdrawn.

2. The Asserted Combination of Utsumi with BountyQuest Fails to Disclose at Least One Element of Claims 1-7, 9-22 and 24-34

The asserted combination of Utsumi and BountyQuest is improper and should be withdrawn. Even if made, however, the asserted combination fails to disclose at least one element of claims 1-7, 9-22 and 24-34. Thus, the rejection of claims 1-7, 9-22 and 24-34 should be withdrawn.

Utsumi fails to disclose or suggest posting an electronic form which displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited by independent claim 1. Additionally, Utsumi fails to disclose or suggest a computer-readable medium having stored thereon an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited by independent claim 24.

Utsumi discloses a first web page that displays patent numbers, technical fields, product fields, filing dates, and claims (*See Utsumi*, pp. 3-4, paragraph 0025) and a second web page that allows for user inputs (*See Utsumi*, p. 4, paragraph 0027). Thus, Utsumi fails to disclose "an electronic form which displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target, as recited by claim 1. Utsumi also fails to disclose or suggest an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target, as recited by claim 24.

Utsumi discloses a single input for entering a posting to the website reporting possession of pertinent information (*See Utsumi*, p. 4, paragraph 0029). Utsumi discloses that the information provider expresses his willingness to provide information in the input window or writes the information itself in the window for transmission to the server management company. *See Utsumi*, p. 4, paragraph 0030. Utsumi fails to disclose or suggest a first user input to identify an infringement target and a second user input to describe how the infringement target meets the criteria, as recited by claims 1 and 24. Moreover, Utsumi fails to disclose or suggest a first user input to identify an infringement target, as recited by claims 1 and 24.

BountyQuest discloses user inputs for specifying a prior art publication, including Author, Title, Publisher, Publication Date, ISBN, Edition and URL. *See BountyQuest*, p. 16. BountyQuest also provides inputs for specifying the location of claims or claim elements described in the prior art publication. *See BountyQuest*, p. 16. BountyQuest fails to disclose or suggest a first user input to identify an infringement target and a second user input to describe how the infringement target meets the criteria, as recited by claims 1 and 24. In fact, BountyQuest teaches away from the claimed invention of claims 1 and 24 since BountyQuest is a system designed to avoid infringement by seeking prior art.

Thus, the asserted combination of Utsumi and BountyQuest fails to disclose or suggest at least one element of independent claims 1 and 24 and of claims 2-7, 9-22 and 25-34, at least by virtue of their dependency from claims 1 and 24. Therefore, the rejection of claims 1-7, 9-22 and 24-34 over the asserted combination of Utsumi and BountyQuest should be withdrawn.

3. Claims 35 and 36 are allowable.

Neither Utsumi nor BountyQuest disclose or suggest the step of providing a trust mechanism to discourage a user from providing a non-useful infringement submission, as recited in claim 35. In addition, neither Utsumi nor BountyQuest disclose or suggest posting an electronic form which displays criteria for infringement of a particular patent and accepts first user input to identify infringement target information and second user input to describe how the infringement target meets the criteria, wherein the infringement target information does not predate the filing date of the particular patent, as recited in claim 36. Therefore, Applicants respectfully submit that new claims 35 and 36 are allowable.

CONCLUSION

Applicants have pointed out specific features of the claims not disclosed, suggested, or rendered obvious by the references applied in the Office Action. Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the rejections, as well as an indication of the allowability of each of the pending claims 1-7, 9-22 and 24-36.

The Examiner is invited to contact the undersigned attorney at the telephone number listed below if such a call would in any way facilitate allowance of this application.

The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

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Date


Jeffrey G. Toler, Reg. No. 38,342
Attorney for Applicants
TOLER SCHAFFER LLP
5000 Plaza On The Lake, Suite 265
Austin, Texas 78746
(512) 327-5515 (phone)
(512) 327-5452 (fax)